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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,191	06/06/2002	Erich Bayer	218082US6PCT	8699

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EXAMINER

SAN MARTIN, EDGARDO

ART UNIT PAPER NUMBER

2837

DATE MAILED: 09/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/030,191

Applicant(s)

BAYER, ERICH

Examiner

Edgardo San Martin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the matter is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6, 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities:
  - The Headings of the different sections of the application are not included;

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

**As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:**

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or

REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a).

"Microfiche Appendices" were accepted by the Office until March 1, 2001.)

(e) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A

"Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

- The reference to Claims 1 and 5 on page 2, lines 10 and 11, to Claim 2 on page 3, line 5, to Claim 5 on page 3, line 9, to Claim 5 on page 4, line 4, to Claim 6 on page 4, line 9, to Claim 7 on page 4, line 13, and to Claim 1 on page 4, line 19 should be deleted;
- The Brief Descriptions of figures 12 – 25 are not included;
- On page 6, last line, the reference to Claim 5 should be deleted;
- The Detailed Descriptions of figures 12 – 25 are not included.

Appropriate correction is required.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 9 – 11, 14 and 15 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 – 3, 7 and 8, respectively of copending Application No. 10/030,192. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.
3. Claims 12 and 13 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 4 of copending Application No. 10/030,192. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.
4. Claims 16 and 17 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 9 of copending Application No. 10/030,192. This is a

provisional double patenting rejection since the conflicting claims have not in fact been patented.

5. Claims 18 – 26 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 14 of copending Application No. 10/030,192. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 9, 14 – 18 and 23 - 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Starkey (US 2,763,334).

With respect to Claims 9 and 14, Starkey teaches an earpiece for behind-the-ear parts of hearing acoustics devices (Figs. 1 and 2), by which a signal conductor (Fig.1, Item 8) that comes from the behind-the-ear device (Fig.1, Item 16) can be positioned in a patient's auditory canal, wherein the earpiece is individually adapted to the patient's anatomy (Fig.1), and a part (Fig.2, Items 14, 9 and 9a) that provides a hold, which

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follows an outer edge of the patient's cavum conchae in an arc shape, at least in segments, wherein a shank (Fig.2, Item 9a) that follows the outer edge of the cavum conchae makes a transition, above the patient's antitragus, into an angled traverse segment that passes through the cavum conchae, which runs in a direction of the patient's porus acusticus externus, and broadens to hold the signal conductor at its end segment, which comes to rest in an upper region of the patient's auditory canal (Figs. 1 – 5; Col.2, Line 9 – Col.3, Line 63).

With respect to Claim 15, Starkey teaches wherein the clip is broadened at the end of the clip and forms a sound tube eye (Figs. 4 – 5, Items 7 and 7a).

With respect to Claims 16 and 17, Starkey teaches wherein the part of the earpiece that provides the hold extends into a region of the patient's crus anthelicis (Fig.1).

With respect to Claims 18 and 23 – 26, Starkey teaches wherein the earpiece is for use with a BTE systems or any other hearing aid device (Fig.1; Col.1, Lines 15 – 38).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10 – 13 and 19 - 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Starkey (US 2,763,334) in view of Boesen (US 6,094,492).

With respect to Claims 10 – 13, Starkey teaches the limitations discussed in the previous rejections, but fails to disclose wherein the end segment makes a transition to an auditory canal tab that also comes to rest only in a top region of the patient's auditory canal, and wherein the auditory canal tab has a diameter that makes up only a fraction of a diameter of the patient's auditory canal.

On the other hand, Boesen teaches an earpiece for behind-the-ear parts of hearing acoustics devices, by which a signal conductor that comes from the behind-the-ear device can be positioned in a patient's auditory canal (Figs. 1 and 2), wherein an end segment makes a transition to an auditory canal tab that also comes to rest only in a top region (Fig.2, Item 26) of the patient's auditory canal (Fig.23, Item 28), and wherein the auditory canal tab has a diameter that makes up only a fraction of a diameter of the patient's auditory canal (Fig.2).



It would have been obvious to a person with ordinary skill in the art to employ the Boesen configuration for insertion of an earpiece to an auditory canal to modify and insert the Starkey earpiece because it would make the earpiece more comfortable to wear, would not occlude or obstruct the external auditory canal of the patient, and would be aesthetically pleasing to the user.

With respect to Claims 19 – 22, Starkey teaches wherein the earpiece is for use with a BTE systems or any other hearing aid device (Fig.1; Col.1, Lines 15 – 38), and Boesen teaches wherein the earpiece is for use with cochlear implant microphones or broad-band noise systems (Col.2, Line 53 – Col.3, Line 26).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rapps teaches a self-retaining element for a behind-the-ear communication device, Smith et al. teach a flexible ear insert and audio communication link, Geers teaches a hearing aid with transmitter and microphone housing parts, Feingold teaches an ear insert for hearing aid, Neal teaches an ear ornament with three-point resilient support within the tragus, the antitragus and the anti-helix, Henderson teaches a hearing aid plastic ear piece, French teaches a hearing aid support, Jones teaches an adjustable earpiece for audiphones, Langenbeck et al. teach a holding means for ear telephones, listening tubes, and similar devices for improving

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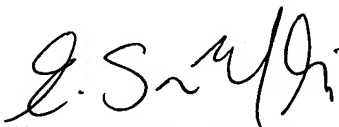
the hearing, Watanabe teaches an earphone cover, Bayer et al. teach a behind the ear hearing aid, Watanabe teaches an earphone, and Bayer et al. teach a plastic insert that fits into ear cavity for a behind the ear hearing aid and has an insert sound tube.

***Contact Information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edgardo San Martin whose telephone number is (703) 308-1050. The examiner can normally be reached on 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Nappi can be reached on (703) 308-3370. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703) 305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.



Edgardo San Martin  
Patent Examiner  
Art Unit 2837  
Class 181  
August 27, 2003